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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,495	04/17/2001	Katsumi Okouchi	01081	5421

7590

10/22/2004

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EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT PAPER NUMBER

3724

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,495

Applicant(s)

OKOUCHI, KATSUMI

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-22, 26, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-15, 18, 19, 30 and 31 is/are rejected.
- 7) ☒ Claim(s) 16, 17, 20-22 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/5/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

1. This office action is in response to applicant's request for reconsideration, wherein no claims were amended. Claims 1-7, 10-22, 26, 30-31 remain pending in the instant application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 10-12, 18-19, and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vavrik, U.S. Patent 2,488,947, in view of Waite, U.S. Patent 5,996,460, or JP 11-170,203, hereinafter JP '203, or JP 60-98,602, hereinafter JP '602.

Vavrik discloses the invention substantially as claimed including, e.g., a saw blade (6); a blade case (1) comprising a blade cover (9/10) adapted to substantially cover at least one lateral side of the saw blade; a light (48) disposed within the blade case, wherein the light is displaced from the saw blade in a lateral direction that is substantially perpendicular to a face of the saw blade, the light is substantially aligned with a cutting line of a workpiece that will be cut by the saw blade during a cutting operation, and wherein the blade cover includes an inner wall (9a).

Vavrik uses a LUCITE rod to transmit the light from an offset location inside the blade case to the blade cover instead of mounting the light directly to a part of the inner wall of the blade cover. However, Waite, JP '203 and JP '602 all disclose that it is old

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and well known in the art to mount lights to blade covers to transmit light to the cutting area of the blade without the use of light transmitting rods for the purpose of reducing the number parts needed for manufacturing the device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to relocate the light to the inner wall of the blade cover such that there is no need for light transmitting rods, as taught by Waite, JP '203, and JP '602 in order to reduce manufacturing costs as well as increasing the light intensity around the blade, because it has been held that rearranging parts of an invention involves only routine skill in the art as well as omissions of elements and its function in combination where the remaining elements perform the same functions as before involves only routing skill in the art.

As to claims 2 and 19, the modified device of Vavrik inherently discloses a mounting device because the light of Vavrik is mounted within the blade case.

As to claims 10-12, the modified device of Vavrik discloses a portable circular saw with a base (12) and pivotally attached saw unit (1, see Figure 6).

As to claim 18, the modified device of Vavrik discloses a saw blade, blade case, motor, and a light as explained above and further including a power supply and coupling wherein the first circuit (e.g. the wires in the motor housing) and the second circuit portion (e.g. the terminals of the light bulb).

As to claim 30, the modified device of Vavrik discloses the use of a gear housing (see Figure 8).

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As to claim 31, the modified device of Vavrik discloses the use of a gear housing (the portion of housing 1 surrounding the gears as shown in Figure 8), a motor housing (the portion of housing 1 surrounding the motor as shown in Figure 1), a power supply and coupling wherein the first circuit (e.g. the wires in the motor housing running from the source) and the second circuit portion (e.g. the terminals of the light bulb).

As to claims 4-7, the modified device of Vavrik discloses the invention substantially as claimed except for the cover member that protects the light and a portion of the power supply circuit from the blade and a gap maintained to permit light; however, JP '203, as shown in Figure 2, discloses that it is old and well known in the art to use covers with gaps in conjunction with lights for the purpose of preventing saw dust build up on the light as well as for protecting portions of the power supply circuit, e.g. the connection between the wire and the light. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a cover and gap with the light of the modified device of Vavrik in order to prevent saw dust from building up on the light as well as for protecting a portion of the power supply circuit.

As to claim 7, the modified device of Vavrik discloses the use of socket and electrical line extending from the socket, wherein the socket is coupled to the mounting device.

4. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vavrik, U.S. Patent 2,488,947, in view of Waite, U.S. Patent 5,996,460, or JP 11-170,203, hereinafter JP '203, or JP 60-98,602, hereinafter JP '602, as applied to claim 1 above and further in view of Ando et al., U.S. Patent 4,555,849.

The modified device of Vavrik discloses the invention substantially as claimed except for elements of the power supply circuit being arranged to horizontally balance the cutting tool when the base extends substantially horizontally and the cutting tool is held by the handle; however, Ando et al. discloses that it is old and well known in the art to use elements of the power supply circuit (namely the battery) arranged to balance the saw when held by the handle and in a horizontal orientation for the purpose of facilitating use of the saw thereby preventing overexertion of the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made arrange elements of the power supply circuit to balance the weight of the saw such that use of the saw is facilitated.

As to claim 14, the modified device of Vavrik discloses the invention substantially as claimed except for the power supply comprising a transformer located in the handle; however, the examiner takes official notice that it is old and well known in the art to use transformers in power supplies for the purpose of providing the specific amount voltage necessary to power the device (e.g. low volt lights). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a transformer with the device of modified device of Vavrik in order to use lower voltage lights with the device. As to the specific location of the transformer in the handle, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the transformer in the handle section of the device in order to balance the weight of the transformer with the sawing device, because it has been held that rearranging parts of an invention involves only routine skill in the art.

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As to claim 15, the modified device of Vavrik lacks separate switches for the saw and light wherein they are positioned adjacent each other. However, at the time of the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use separate switches for the blade and light in order to allow the light to help align the blade without the blade being activated because applicant has not disclosed that separate switches provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, would have expected applicant's invention to perform equally well with two switches because both one and two switch devices perform the same function of allowing the saw and light to be powered. Therefore, it would have been obvious matter of design choice to modify the modified device of Vavrik to obtain the invention as specified in claim 15.

Allowable Subject Matter

5. Claims 16-17, 20-22 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments filed 7/8/04 have been fully considered but they are not persuasive.

Applicant contends that the examiner has not provided any support for the motivation to relocate the light of Vavrik to the inner wall of the blade cover such that there is no need for light transmitting rods because there is neither support for the

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arguments of rearrangement of parts nor the elimination of a part and its function.

Applicant further points to MPEP 2144.04(ii)(B) for support of this argument.

The examiner disagrees with the applicant for the following reasons. Section MPEP 2144.04(II)(B) is clearly directed to the situation where the function of the eliminated element remains. That is not the case here. The function of the light tube does not remain after the elimination of the tube. In this case, the rejection requires relocation of the light for the device to work as also admitted by the applicant. It has been held that omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before.

As to applicant's comments regarding the relocation of parts, it should be noted that it has been held that rearranging parts is within the level of ordinary skill in the art when there are no unexpected results. In this case, there are no unexpected results.

Furthermore, that is not the only interpretation of the above rejection. It is clear from the date of the Vavrik reference that the only reason for the light tube is to allow the bulb to be placed outside of the guard because of the size of light bulbs at the time of the invention. With the advancement of the technology in the light bulb and light tube transmission art, light bulbs and tubes have become increasingly smaller allowing placements in once forbidden location do to size contains. Therefore, it is not necessary to remove the tube just to resize the bulb and tube and then relocate the bulb and tube. Such a situation would allow for greater beam direction and control.

Applicant contends that the examiner is merely using hindsight reason; however, it must be recognized that any judgment on obviousness is in a sense necessarily a

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reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In this case, the examiner is only taken into account knowledge which is within the level of ordinary skill in the art, such as relocation of parts and elimination of parts.

7. For the reasons above, the grounds of rejection are deemed proper.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

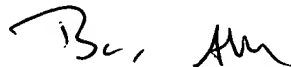
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Boyer D. Ashley
Primary Examiner
Art Unit 3724

BDA
October 21, 2004